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750 B STREET
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PETER SHINTANI and LUDOVIC ETIENNE DOUILLET

Appeal 2015-002220¹
Application 13/034,093²
Technology Center 3600

Before JOSEPH A. FISCHETTI, JAMES A. WORTH, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

WORTH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final rejection of claims 1–9. We have jurisdiction under 35 U.S.C. §§ 134 and 6(b).

We AFFIRM-IN-PART.

¹ Our decision refers to the Appellants' Appeal Brief ("Appeal Br.," filed July 9, 2014) and Reply Brief ("Reply Br.," filed Nov. 13, 2014), and the Examiner's Final Office Action ("Final Act.," mailed May 7, 2014) and Answer ("Ans.," mailed Nov. 12, 2014).

² According to Appellants, the real party in interest is Sony Corp. (Appeal Br. 4).

Introduction

Appellants' disclosure relates to "to activating a licensable component using an aggregating device in a home network." (Spec. 1, ll. 7–8).

Claim 1, reproduced below, is the sole independent claim on appeal and is illustrative of the subject matter on appeal:

1. Aggregation device for a system comprising the aggregation device and at least one other audio video apparatus communicating with the aggregation device, the aggregation device comprising:
 - processor;
 - computer readable storage medium bearing instructions executable by the processor to configure the processor by executing the instructions to:
 - determine that at least one licensable component of the audio video apparatus requires activation; and
 - responsive to the determination that the licensable component requires activation, communicate to a server using a network that a license event has occurred.

(Appeal Br., Claims App.)

Rejections on Appeal

The Examiner maintains, and Appellants appeal, the following rejections:

- I. Claims 1–9 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. (Ans. 2).

- II. Claims 1–6, 8 and 9 stand rejected under pre-AIA 35 U.S.C. § 102(e) as being anticipated by Houg (US 2011/0166968 A1, pub. July 7, 2011). (Final Act. 6).
- III. Claim 7 stands rejected under pre-AIA 35 U.S.C. § 102(e) as being unpatentable over Houg and Official Notice. (Final Act. 11).³

ANALYSIS

Rejection I (Unpatentable Subject Matter)

Claims 1–9

The Examiner determines that claims 1–9 are directed to an abstract idea of “activating a device” and that additional claim limitations do not provide meaningful limitations to transform the abstract idea into a patent eligible application (Ans. 2).

We are persuaded by Appellants’ argument that the claims are not directed to an abstract idea such as an economic activity or a method of organizing human behavior. *See* Reply Br. 2–7 (citing *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. ____ (2014); *Buysafe, Inc. v. Google, Inc.*, No. 2013-1575 (Fed. Cir. Sept. 3, 2014)). While the Court in *Alice* made a direct finding as to what the claims were directed to, we find that this case’s claims themselves and the Specification provide enough information to inform one as to what they are directed to. We determine that the claims are directed to a method of validating a device over a network that is “designed to achieve an improved technological result in conventional industry practice,” whether

³ A rejection under 35 U.S.C. § 112, paragraph two, and an older version of the rejection under 35 U.S.C. § 101 have been withdrawn.

or not the claimed invention is new or nonobvious over the prior art of record. *See Mcro, Inc. v. Bandai Namco Games America*, No. 2015-1080 (Fed. Cir. Sept. 13, 2016). Thus, we do not sustain the Examiner's rejection under § 101 of claims 1–9.

Rejection II (Anticipation)

Dependent claim 3

We are persuaded by Appellants' argument that paragraphs 69 and 70 of Houg fail to disclose "data format," as recited in dependent claim 3, i.e., "determine that at least one licensable component of the audio video apparatus requires activation by inference based on a format of data received from the audio video apparatus" (Appeal Br. 4). Appellants assert that Houg only provides a code or key such as a serial number of the display device (*id.*). The Examiner relies on the registration code in paragraph 69 of Houg (Ans. 5).

Appellants assert that the Specification (p. 8) distinguishes between serial numbers and data formats (Reply Br. 8). The Specification states that the request identifies the component with a serial number regardless of how the request is made (Spec. 8, l. 10). We are persuaded by Appellants that the Specification distinguishes between a request for activation and the serial number that identifies the unit being activated, and that it would be inconsistent with the Specification to rely on a serial number as both a unique identifier and as a data format for requesting activation. As such, we agree with Appellants that Houg's registration code, which is a unique identifier of the display device, does not meet the limitation "determine that at least one licensable component of the audio video apparatus requires activation by inference based on a format of data received from the audio

video apparatus.” Therefore, we do not sustain the Examiner’s rejection under § 102(e) of claim 3.

Dependent claim 6

We are unpersuaded by Appellants’ argument that paragraphs 50 and 51 of Houg fail to disclose that codes are provided immediately upon establishing a network connection, as recited in dependent claim 6, i.e., “wherein the processor of the device is configured by the instructions to inform the server of the license event immediately upon establishing a network connection with the network” (Appeal Br. 5). Appellants assert that the mere capability is not enough to satisfy the claim requirement which requires more than an intended use (Reply Br. 9). Whether or not there is a difference between “configured to” and a “capable of,” as argued, we agree with the Examiner that the limitation is amply met by paragraphs 50 and 51 of Houg, which discloses that the activation process includes a notification. Therefore, we sustain the Examiner’s rejection under § 102(e) of claim 6.

Dependent claim 8

Appellants argue that paragraphs 69 and 72 of Houg fail to disclose identification of an aggregation device, as recited in dependent claim 8, i.e., “wherein the processor of the aggregation device is configured by the instructions to communicate to the server using the network that the license event has occurred along with an identification of the aggregation device only.” (Appeal Br. 5). The Examiner states that Houg is “silent in regard to what other information is transmitted” but reasons that the “Houg’s teaching could be implemented by sending a serial number only.” (Ans. 7).

Appellants assert that the mere capability is not enough to satisfy the claim requirement which requires more than an intended use (Reply Br. 10).

We find that although paragraphs 69 and 72 of Houng describe notification sent to the user, this portion of Houng does not adequately describe notification sent “to the server,” as recited. Therefore, we do not sustain the Examiner’s rejection under § 102(e) of claim 8.

Independent claim 1 and dependent claims 2, 4, 5, and 9

Appellants do not contest the Examiner’s rejection under § 102(e) of claims 1, 2, 4, 5, and 9. As such, the arguments are waived. 37 C.F.R. § 41.37(c)(1)(iv). We, therefore, sustain the Examiner’s rejection under § 102(e) of claims 1, 2, 4, 5, and 9.

Rejection III (Obviousness)

Dependent claim 7

We are unpersuaded by Appellants’ argument that the Examiner has failed to provide evidence of Official Notice that it was known in the art to have a processor configured to inform the service of the license event after a predetermined quiescent period of time, as recited in dependent claim 7, i.e., “wherein the processor of the device is configured by the instructions to inform the server of the license event after a predetermined period of quiescent time.” (Appeal Br. 6). The Examiner points to Vijay (US 2014/0013449 A1, pub. Jan. 9, 2004) (Abstr., ¶ 24) as evidence thereof (Ans. 10). Appellants assert that Vijay does not disclose a “predetermined” period and only teaches validation internal to a device during off-peak hours (Reply Br. 10). Vijay (¶ 24) states that validation may be delayed, and provides an example in which validation is performed at midnight in order to

be performed at off-peak hours. We determine that delaying validation until midnight is within the broadest reasonable interpretation of waiting “a predetermined period of quiescent time” and that Vijay adequately supports the Examiner’s taking of Official Notice that it would have been known to delay validation for “a predetermined period of quiescent time.”

Accordingly, we sustain the Examiner’s rejection under § 103 of claim 7.

DECISION

The Examiner’s decision to reject claims 1, 2, 4–7, and 9 is affirmed.

The Examiner’s decision to reject claims 3 and 8 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART